

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Hiroteru TSUCHIYA

Title: IMAGE TRANSMISSION DEVICE AND INFORMING
METHOD THEREOF

Appl. No.: 10/077,891

Filing Date: 2/20/2002

Examiner: Stephen M. Brinich

Art Unit: 2625

Confirmation 3110
No.

06/20/2008 CKHLOK 00000002 190741 10077891

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**RENEWED PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE HOLDING OF
ABANDONMENT, OR, IN THE ALTERNATIVE, REQUEST TO REVIVE
APPLICATION UNDER UNINTENTIONAL ABANDONMENT**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests reconsideration of the decision mailed March 3, 2008, dismissing Applicant's petition to withdraw a holding of abandonment of the present application. Applicant believes that no fee is due in connection with this Renewed Petition to Withdraw Holding of Abandonment. However, the Commissioner is hereby authorized to charge any fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741.

As demonstrated below, the original holding of abandonment is incorrect. No further corrected formal drawings have ever been due in the case. The record does not contain a single stated error relative to the drawings. Moreover, the Patent Office Examiner sent a corrected Notice of Allowance replacement page to correct an erroneous indication in the original Notice of Allowance stating that corrected drawings were due.

Should the request for reconsideration be denied, then and only then, in the alternative, Applicant requests that the case be revived under unintentional abandonment.

I. BACKGROUND FACTS

The present application was filed on February 20, 2002, including formal drawings (Exhibit No. 1 contains the formal drawings as scanned by the Patent Office). The Patent Office mailed a first Office Action on December 14, 2005. The first action did not contain any objections to the drawings. During the subsequent prosecution, including a first Reply filed March 9, 2006, a second Office Action on May, 30, 2006, and a Second Reply filed August 25, 2006, the Patent Office made no objections to the formal drawings, nor did the Applicant make any changes to the drawings.

On November 17, 2006, the Patent Office Examiner mailed a Notice of Allowance (Exhibit No. 2). The Notice of Allowance included a Notice of Allowability form PTOL-37. This form erroneously indicated that corrected drawings were due, and referred to a Notice of Draftperson's Patent Drawing Review (PTO-948). No Draftperson's review was attached, none is listed under "Attachment(s)" at the bottom of form PTOL-37, and none has ever been supplied.

The Notice of Allowability form PTOL-37 was not itself signed. Rather, only the last page of the overall Notice of Allowance was signed by the Examiner. The Notice of Allowance further contained the following language under the Conclusions section:

2. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

....

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300 (as of July 15, 2005).
Notice of Allowance, pp. 2-3.

Recognizing that the Notice of Allowability contained an erroneous request for corrected drawings, and following the language of the Notice of Allowance, Applicant's representative contacted Examiner Brinich on December 6, 2006. Examiner Brinich entirely agreed that the request for corrected drawings was erroneous.

Examiner Brinich provided an updated replacement page of the Notice of Allowability on December 6, 2006. Exhibit No. 3 contains the replacement page, together with the

faxcover from the Tech Center. The faxcover contains an official seal of the U.S. Patent & Trademark Office. The faxcover identifies the application number, the Examiner name and contact information, and the date and time of transmission. The Official Fax Number identified on the faxcover is the same as that on page 3 of the Notice of Allowance. As seen on the replacement page of the Notice of Allowability, no corrected drawings are due.

Applicant timely paid the issue fee on February 15, 2007. Exhibit No. 4.

The Patent Office mailed a Notice of Abandonment on March 19, 2007. The only stated reason for the holding of abandonment is that no corrected drawings were filed.

II. THE HOLDING OF ABANDONMENT IS ERRONEOUS BECAUSE NO CORRECTED DRAWINGS WERE DUE

The only basis for the holding of abandonment is alleged failure to file corrected drawings. However, the entire Patent Office record makes very clear that no further formal drawings are due. The application as filed contained formal and complete drawings. *See Exhibit No. 1, and no error* has ever been identified in the drawings. At no time during prosecution leading to the Notice of Allowance was any objection or change made to any application drawing.

The Notice of Allowability erroneously contained a checked box that corrected drawings were due, referencing a non-existent Notice of Draftperson's Patent Drawing Review. *See Exhibit No. 2.* The Patent Examiner confirmed in writing that no drawing corrections were due. *See Exhibit No. 3.* The Notice of Allowability contained a simple typographical error, which the PTO Examiner entirely acknowledged and corrected.

The application file all along contained the correct formal drawings. To the extent that the Notice of Allowance stated any requirement for correct formal drawings, the application file already contains them and the requirement is met.

This case is not a situation where some correction to the drawings was actually due, and Applicants tried to traverse it without filing formal drawings. No changes to the drawings have ever needed to be made in this case. The application file has the correct formal drawings.

Nothing in the PTO regulations or Manual of Patent Examining Procedure directs abandoning an application based on an erroneous indication in a Notice of Allowance that

corrected drawings are due when the case in fact contains the correct formal drawings. The petitions dismissal does not point to any statute, regulation or MPEP section that states to abandon a case based on an erroneous request for corrected drawings.

The Applicant met all the PTO regulations for formal drawings. The basis for abandoning the case, that corrected drawings are due, cannot hold when the case contains the correct formal drawings.

III. ANY UNCERTAINTY REGARDING THE NOTICE OF ALLOWANCE WAS CLARIFIED, IN WRITING, BY THE PATENT OFFICE EXAMINER

Upon review of the Notice of Allowability PTOL-37, Applicant's representative realized that the indication for corrected drawings must be an error. Following the language of the Notice of Allowance, Applicant's representative contacted the PTO Examiner. The PTO Examiner entirely agreed that the corrected drawing indication was erroneous. The PTO Examiner faxed a corrected replacement page of the Notice of Allowability, identical in every respect to the first Notice of Allowability page, but removing the typographical error.

The petition dismissal characterizes the PTO Examiner's facsimile as unofficial, including because it was not signed and did not contain a response date. But, the PTO Examiner had no reason to separately sign the replacement PTOL-37 page, especially considering that the first PTOL-37 page itself was never signed. Nor was there any reason for the facsimile to have a response date; the Notice of Allowance mailed on November 19, 2006 already contained the response date and it remained unchanged. Further, the petition dismissal relies on the lack of an interview summary. Yet, the MPEP says otherwise:

Discussions regarding only procedural matters . . . or pointing out typographical errors in Office actions or the like, are excluded from the interview recordation procedures below.

MPEP § 713.04 (emphasis added).

In this case, the Applicant and PTO Examiner addressed a typographical error in the Notice of Allowability. The MPEP excludes the interview summary procedures in this circumstance.

Moreover, the facsimile is official. The faxcover contains the U.S. Patent Office logo. The faxcover identifies the application number, the Examiner name and contact information,

and the date and time of transmission. The faxcover comes from the Patent Office Tech Center, the same place for formal facsimile transmissions as stated in the Notice of Allowance. The petitions dismissal points to no PTO regulation or MPEP section demonstrating that such a facsimile transmission is not official. In fact, the Patent Office provides other communications by facsimile in much the same way. For example, the Assignment Branch faxes Notices of Recordation of Assignments using the same kind of faxcover, which are not signed, have no response date, have no interview summary to go with them, etc. As an example, see Exhibit No. 5. Any reasonable understanding is that such facsimiles are official. Analogously, in the present situation, the PTO Examiner faxed a replacement Notice of Allowability to correct a typographical error in an application when the record was quite clear that no further corrections to formal drawings were due. Any reasonable understanding is that such a facsimile is official.

The petitions dismissal likens the present case to an oral communication from the PTO Examiner, stating that a "delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP" is not unavoidable due to reliance of oral advice or the USPTO's failure to advise applicants of deficiencies in time for applicant to correct them. Applicant respectfully believes that such a characterization has no merit. The PTO Examiner sent a written communication correcting the typographical error in the Notice of Allowance. It was not oral advice. It was a written confirmation that no further formal drawings were due. Moreover, the petitions dismissal cites no statute, rule of practice or section in the MPEP that states that an erroneous requirement for corrected drawings is sufficient for a holding of abandonment. The petitions dismissal does not point to a single statute, rule of practice or MPEP section that requires applicants to request a corrected Notice of Allowance in this circumstance (which was done anyway) and otherwise the case becomes abandoned. In this case, the Applicant went beyond the requirements of the statutes, regulations and MPEP in contacting the PTO Examiner and obtaining written confirmation of the fact that no further formal drawings were due.¹

¹ To the extent that the PTO Examiner then committed a further error by failing to submit the replacement page into the Patent Office database (which the Applicant best understands is what the petitions dismissal refers to as the official written record), the burden of that error cannot be placed on the Applicant.

Finally, the statutory requirements in terms of specification, drawings, fees, and patentability were all met. Applicant respectfully believes that the Patent Office does not have the authority to abandon the case based on an erroneous indication that corrected drawings were due.

For all the foregoing reasons, Applicant respectfully requests that the holding of abandonment be withdrawn in this case. If the Patent Office continues to take the position that the petition to withdraw abandonment should not be granted, the appropriate petitions examiner is respectfully requested to contact the undersigned.

IV. PETITION TO REVIVE APPLICATION UNDER 37 C.F.R. § 1.137(b)

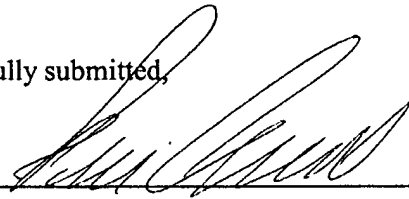
If the request for reconsideration above is not granted, then and only then, Applicant respectfully requests that the case be revived because it was unintentionally abandoned. (In this regard, it is noted that the issue fee was timely paid, and the original petition to withdraw abandonment was filed less than 6 months after the Notice of Allowance.) Exhibit No. 6 contains the necessary signed form to revive the application under 37 C.F.R. 1.137(b). The Patent Office is authorized to charge Deposit Account No. 19-0741.

Respectfully submitted,

Date

April 18, 2008

By



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